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Remarks

We have added new claim 6 so that claims 1-6 are now pending.

Claim objection

The Examiner has objected to claim 5 indicating that the term "angle", in line 6, should be -- angles --. The phrase in claim 5 including line 6 and the word "angle" reads "said closely spaced end surfaces of said four display lengths of decorative film each having two projecting surface portions disposed at a right angle with respect to each other." Alternatively stated, each of the end surfaces of the four display lengths has two projecting surface portions, which two projecting surface portions are disposed at a right angle with respect to each other. The use of angle is believed to be correct. Reconsideration is requested.

§ 112 Rejections

The Examiner has rejected Claims 1-5 under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention; has indicated that the Examiner has been unable to find support in the original specification for the new language in claims 1 and 5; and has stated "Please cancel this language or recited where support can be found for it".

The "new language" in claim 1 includes the language underlined below in recitation defining the display lengths of decorative film tape:

"a plurality of display lengths of decorative film tape each comprising a length of decorative film having opposite parallel edge surfaces, opposite end surfaces at opposite ends of said length of decorative film, opposite major surfaces extending between said edge and end surfaces, and a layer of adhesive along one of the major surfaces"

"said display lengths of decorative film tape having different lengths and shapes of said end surfaces formed by a computer operated tape applicator and being applied to the first surface of the release liner by said tape applicator with end surfaces of some of said display lengths closely spaced from each other to form a decorative pattern;"

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The word "plurality" is found many places including at page 8, line 27.

That the decorative film in such a tape has opposite parallel edge surfaces, opposite end surfaces at opposite ends of said length of decorative film, and that its opposite major surfaces extend between those edge and end surfaces is not specifically recited in the specification using the language of claim 1, but is structure common to a decorative film that is the backing of a tape, and can be seen in the lengths of tape forming the laminates illustrated in Figures 1 and 7 of the specification.

That the display lengths of decorative film have different shapes of their end surfaces formed by a computer operated tape applicator is also not specifically recited in the specification using the language of claim 1, but can be seen in Figures 1 and 7 where the end surfaces of the display lengths of decorative film have different shapes, and will be understood by a careful reading of the description and operation of the tape applicator 10 beginning at page 12, line 20 of the application. Also, it can be seen in Figures 1 and 7 that the end surfaces of some of the display lengths of decorative film are close to each other to form a decorative pattern, and the close spacing of those end surfaces and the reason for it is recited from page 26, line 28 to page 27, line 2 of the specification.

New claim 5 recites that the decorative pattern formed by the display lengths of decorative film as recited in claim 1

"comprises a plurality of pattern portions, each of said pattern portions being formed by four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from said adjacent closely spaced end surfaces, said closely spaced end surfaces of said four display lengths of decorative film each having two projecting surface portions disposed at a right angle with respect to each other."

The language in claim 5 is also not specifically recited in the specification, however the structure it describes can be seen in Figures 1 and 7 where numerous portions of the patterns illustrated have four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from those adjacent closely spaced end surfaces, the closely spaced end surfaces of the four display lengths of decorative film each having two projecting surface portions disposed at an angle with respect to each. Also the

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specification from page 23, line 18, through page 27, line 16 with reference to Figures 19 through 22 of the Drawing describes the formation of the portions of the pattern claimed in claim 5.

Thus, the new language in claim 1 and in claim 5 is well supported by the specification and drawing, so that the rejection under 35 USC § 112, second paragraph, should be withdrawn. We will, however, if requested by the Examiner, amend the specification to include the new language of claims 1 and claim 5, as there would be no issue of new matter by making such amendments.

§ 103 Rejections

The Examiner has rejected Claims 1, 2, 3, 4, and 5 under 35 USC § 103(a) as being obvious over Sundet (#5,665,446); and has also rejected Claim 3 under 35 USC § 103(a) as being obvious over Sundet with Futhy.

Sundet describes a laminate that can be adapted for use to decorate a substrate, which, like the laminate according to the present invention, comprises (1) a layer of pre-mask material comprising a cover layer and a layer of removable adhesive firmly adhered to one surface of the cover layer; (2) a plurality of decorative films each having a layer of adhesive along one of their major surfaces; and (3) a release liner with a first major surface adapted to be releasably adhered to by the removable adhesive on the cover layer and by the adhesives on the decorative films. Also, as in the laminate according to the present invention, the decorative films of Sundet are applied to the first surface of the release liner in a pattern, and the layer of removable adhesive included in the layer of pre-mask material is adhered over the outer major surfaces of the decorative films adhered to the release liner and to the release liner around the decorative films.

Unlike the laminate according to the present invention, however, the decorative films or "graphics" in the laminate of Sundet are each formed in one piece by cutting them from a large sheet of the film material as with a computer controlled knife or a die cutter and then removing the weed from around the decorative films (see column 5, lines 33 - 41 of Sundet). Thus the decorative films have shapes such as the W illustrated in Figure 1 of the drawing in Sundet.

In contrast, the laminate adapted for use to decorate a substrate according to the present invention includes a plurality of display lengths of decorative film tape each comprising a length

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of decorative film having opposite parallel edge surfaces, opposite end surfaces at opposite ends of the length of decorative film, opposite major surfaces extending between said edge and end surfaces, and a layer of adhesive along one of the major surfaces; which display lengths of decorative film tape have different lengths and shapes of their end surfaces formed by a computer operated tape applicator and are applied to the first surface of the release liner by that tape applicator with end surfaces of some of the display lengths closely spaced from each other to form a decorative pattern.

There is no teaching or suggestion in Sundet to form graphics using lengths of tape having parallel side surfaces by placing ends of the lengths of tape closely together.

Thus, the laminate adapted for use to decorate a substrate according to the present invention as claimed in claim 1 is not made obvious by Sundet.

Claims 2 through 5 are dependent on claim 1 and are thus allowable for all of the reasons given above with respect to claim 1. Also, those dependent claims recite structural features that are not taught or suggested by the cited art in the combinations claimed. For example:

Claim 2 recites that the spaces between the closely spaced end surfaces of the lengths of tape are in the range of 0.005 to 0.12 inch or 0.013 to 0.3 cm. The Examiner has rejected Claim 2 under 35 USC § 103(a) as being unpatentable over Sundet (#5,665,446). As noted above, there is no teaching or suggestion in Sundet to form graphics using lengths of tape having parallel side surfaces by placing end surfaces of the lengths of tape closely spaced from each other, and therefore no teaching or suggestion of the claimed range of spaces between the closely spaced end surfaces of the lengths of tape.

Claim 3 recites that lengths of decorative film have grooves or other structure along the major surface of the decorative film opposite the layer of adhesive so that the decorative film visually simulates a decorative structure. The Examiner has rejected claim 3 under 35 USC § 103(a) as being unpatentable over Sundet alone and also as being unpatentable over Sundet in view of Futhey et al (#5,840,407) noting that Futhey et al describes such decorative film while Sundet does not. Applicants acknowledge that such lengths of decorative film were well known prior to the present invention, and that such lengths of decorative film have been used to decorate substrates particularly including glass substrates. There has, however, been no laminate of the

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type claimed that includes such lengths of decorative film formed and applied by a computer operated tape applicator to form a decorative pattern.

Claim 5 dependent on claim 1 recites that the decorative pattern in the laminate according to the present invention comprises a plurality of pattern portions, each of which pattern portions is formed by four display lengths of decorative film having adjacent closely spaced end surfaces and extending in four different directions from said adjacent closely spaced end surfaces, said closely spaced end surfaces of said four display lengths of decorative film each having two projecting surface portions disposed at a right angle with respect to each other. There is no teaching or suggestion of such pattern portions in any of the cited references.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration and allowance of all of the claims in the application are respectfully requested.

Respectfully submitted,

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Date

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